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09/241,825 02/01/99 LYTE

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EXAMINER

HM22/1221

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Application/Control Number 09/241,825
Art Unit 1651



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/241,825
Filing Date: February 1, 1999
Appellant(s): Lyte

12/21/00

Mark A. Litman
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 05, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief on Page 8.

(2) *Related Appeals and Interferences* A statement identifying the real party in interest is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement

- a. that Group I containing claims 23, 24, 27 and 28 stand or fall with the patentability of Claim 23;
 - b. that Group II containing claims 25, 26 and 29 stand or fall with the patentability of Claim 25
- and
- c. that Group III containing claims 31-42 stand or fall with the patentability of Claim 31 and each of the above Groups I, II or III do not fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Claim 30 has not been placed in the Grouping of the claims.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-42 stand rejected under 35 U.S.C. 251. This rejection is set forth in prior Office action, Paper No. 6, Paragraph 3 dated March 24, 2000 which is reproduced on pages 4-14 as follows:

COPY OF FINAL REJECTION-----

"3. The prior rejection stands as stated in the previous Office action based on the following:

**FACTOR I--ABANDONMENT OF CLAIMED SUBJECT MATTER
BASED ON THE INSTANT FILE HISTORY**

The Declaration filed by Applicant, stated on page 9 that:

"It was absolutely clear to me at the time of reviewing the rejections under 35 U.S.C. 102 that the rejections were clearly in error with respect to the inventions which I thought was being claimed at the time. With clear instructions and explanations that I gave the attorney, I still do not understand why the rejection was not argued and readily overcome. It was only upon seeing the actual claims which issued in the LYTE Patent on May 13, 1997 that I became aware of and appreciated the error that there were no claims in the LYTE Patent which covered the important invention of enhancing the growth of bacteria and viruses and harvesting by-products of the bacteria[1] and virus."

The file history [07/847,196] clearly shows that Applicant Lyte had **ABANDONED** any inventions pertaining to enhancing the growth of bacteria and viruses and harvesting by-products of the bacterial and virus based on the file history of Application Ser. No. 08/266,805 now U.S. Patent 5,629,349 which is the basis for this Reissue Application Ser. No. 09/241,825. The filing date of this application [Serial Number 08/266,805] is JUNE 27, 1994. The first action in this Application was a restriction submitted on [January 31], 1995 as noted below:

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15. Receipt is acknowledged of the preliminary amendments filed June 27, 1994 and the prior art information disclosure statement filed September 23, 1994.
16. Claims 24-28 are present in the instant application.
Claims 1-23 and 29-36 have been cancelled.
17. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
I. Claims 24 and 25, drawn to a method of suppressing the growth of **Gram-positive** organisms with an amount of catecholamine, classified in Class 514, subclass 727.
II. Claims 26-28, drawn to a method of suppressing the growth of **Gram-negative** organisms by the introduction of an effective blocker of catecholamine receptor sites of the organisms, classified in Class 514, subclass 224.8.
18. The inventions are distinct, each from the other because of the following reasons these inventions have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention, thusly the restriction for examination purposes as indicated is proper.
19. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

H.J.Lilling: HJL
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Art Unit 1808
January 31, 1995

The first action on the merits [in Serial Number 08/266,805] essentially was only to the rejection of the elected invention and there were no rejections based on prior art:

15. Receipt is acknowledged of the election filed February 10, 1995.
16. Applicant has elected Invention I, claims 24-25.
Claims 26-28 have been withdrawn from consideration.
17. Claims 24-25 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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18. The references of record do not anticipate the claimed inventions which includes References R (Qualliotine et al) and S (Denisenko et al) nor do these references suggest the claimed inventions.
 19. No claim is allowed.

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1808
March 21, 1995

The rejections as reviewed by Applicant Lyte were submitted by another Examiner in the parent application [Serial Number 07/847,196] on September 13, 1992. During the prosecution of the claims under consideration at that time including generic claims were abandoned due to the rejections by the Examiner. No restrictions were submitted since Applicant did not present any inventions which were restrictable based on the generic claim that was found not to be allowable. Applicant Lyte had effectively abandoned the generic claim in view of the claims submitted in Ser. No. 08/266,805 which were drawn to inventions drawn to methods of suppressing the growth... and no claims were submitted to methods of enhancing the growth....

From September 13, 1992 to May 12, 1997, Applicant Lyte had the opportunity prior to the issue of the patent [5,629,349] to submit claims covering "the important invention of enhancing the growth of bacteria and viruses and harvesting by-products of the bacterial and virus."

Applicant Lyte would have to submit evidence on the record that he did not abandon the claimed subject matter by presenting certified copies of the alleged "clear instructions and explanations that I gave the attorney".

Applicant is entitled within two years from the date of the **original patent**, 35 U.S.C. 251 which presumes diligence, to cover any broadening or narrowing of the claimed inventions pertaining to the allowed claims 1 and 2 of the patent and reissue claims 1 and 2. However, the issue of the claimed subject matter to a **different invention** based on the record involves a lack of diligence on the part of Applicant to submit an application to the different and patentably distinct

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subject matter. The Reissue provision of 35 U.S.C. 251 does not cover corrections for the lack of diligence and the abandonment of the claimed subject matter which subject matter was not present in the original **patented application** for the alleged generic claims.

Applicant is not within the guidelines of Section 251 that there was an error within meaning of "recapture rule" based on the history and the patented claims under consideration.

The failure of Applicant to file claims to the subject matter submitted in the reissue in an earlier application cannot be corrected by the reissue since this failure is not considered an error within the meaning and scope of claiming less than the applicant had a right to claim. Applicants' failure to timely file another application to the claimed subject matter is not considered to be error causing a patent granted on examined claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251.

FACTOR 2-Reissue Applications **DIFFERENT INVENTIONS**

New claims 23-42 are drawn to an invention which is not considered to conform to the same general invention as the original patent. That is, claims 23-42 are drawn to patentably distinct inventions. The originally claimed inventions, Claims 1-2, are drawn to a method of "**suppressing the growth** of... bacteria..."(Claims 3-11) which inventions are **directly opposite** to Claims 23-42 which are drawn to "**enhancing the growth** of bacteria.." (Claims 23-31) and "**harvesting the by-products of enhance growth** of bacteria..". (Claims 32-42).

In addition, as stated in the previous Office action which has been maintained for the amended claims that there was absolutely no search and examination of any aspect to any methods of **enhancing the growth** of bacteria which methods are **completely different from the allowed** claimed methods of **suppressing the growth** of bacteria. In view of the fact that it is well considered in the art that enhancing the growth cannot meet the claimed limitation of suppressing the growth of bacteria, the claims do not generally conform to the general invention as originally elected and allowed in the original patent.

These patentably distinct inventions, (Claims 23-42), would have been restricted along with the other inventions as set forth in the restriction election in the Office action of 31 January 1995, had they been presented at that time for the reasons above. It is not the purpose of reissue to recapture claimed subject matter deliberately canceled in an application to obtain a patent or to claim subject matter that is patentably distinct from the allowed claimed subject matter. It is safe to assume that had claims 23-42 been originally presented, these claims would have been restricted and ultimately canceled prior to issue. Accordingly, claims 23-42 stand withdrawn from further consideration on the merits.

THE REISSUE TO A PATENT

Applicant is entitled to submit claims in a request for Reissue based on claims that were submitted in Application Ser. No. 08/266,806 now U.S. Patent 5,629,349. Applicant is not entitled to the broadening or narrowing of claimed subject matter that [was] submitted and prosecuted in the grandfather application(s). The decisions pertaining to reissue does not cover the claimed subject matter of the grandfather application Ser. No. 07/847,196 filed March 06, 1992 which was abandoned. Applicant arguments and amendments must be drawn to the claimed subject matter that was under consideration for the claims submitted for examination at the time that this Examiner had first examined Application Ser. No. 08/266,805, now U.S. Patent 5,629,349 for which the reissue has been submitted to the PTO. Applicant allegations and arguments have been deemed not to be persuasive in view of the fact that the claimed subject matter is considered to be drawn to a different invention that would have been restricted if the claimed subject matter was submitted at the time of the first examination by this Examiner.

An error of law is not excluded from the class of error subject to correction in accordance with the reissue statute. Although attorney error is not an open invitation to reissue in every case in which it may appear, see *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986) ("not every event or circumstance that might be labeled 'error' is correctable by reissue"), the purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive.

The law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue. Failure of the attorney to claim the invention sufficiently broadly is "one of the most common

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sources of defects". In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985):

Subjective intent is not determinative of whether the applicants erred in claiming less than they had a right to claim. In re Mead, 581 F.2d 251, 255, 198 USPQ 412, 416 (CCPA 1978). "Intent to claim" is not the criterion for reissue, and has been well described as "but judicial shorthand, signifying a means of measuring whether the statutorily required error is present." In re Weiler, 790 F.2d 1576, 1581, 229 USPQ 673, 676 (Fed. Cir. 1986) (emphasis in original). The statutory standard of reissuable error is objective, and does not require proof of subjective state of mind:

**LACK OF INTENT TO CLAIM THE SPECIES NOW
CLAIMED IN THE REISSUE**

In accordance with the M.P.E.P., Claims 23-42 are rejected under §251 as containing claims to different inventions that were not submitted in the original patent, U.S. 5,629, 349.

In Section 1450 Restriction and Election of Species states:

"The examiner may not require restriction in a reissue application (37 CFR 1.176 and MPEP § 1440).

Even where the original patent contains claims to different inventions which the examiner considers independent and distinct, and the reissue application claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction may only be requested by the applicant (37 CFR 1.177 and MPEP § 1451). In situations where a reissue applicant presents claims for the first time that are distinct and separate from the claims of the patent, the examiner must follow the practice resulting from In re Amos, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) as set forth in MPEP § 1412.01.

A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also In re Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978)."

Likewise, if the original patent specification shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. In these situations, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See also MPEP § 1412.01. When the original patent contains claims to a plurality of species and the reissue application contains claims to the same species, election of species should not be required even though there is no allowable generic claim. If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected, where appropriate, for lack of defect in the original patent and lack of error in obtaining the original patent as discussed above."

Response to the remarks by Applicant submitted on September 20, 1999.

The previous Office action of June 25, 1999 is proper and has been maintained for the reasons submitted above.

1. Page 4-Statement: "It was understood by Counsel that the position expressed by the Examiner was that claims could be amended in a broadening Reissue but that entirely new claims could not be submitted."

Examiner never indicated this statement as stated above and Applicant is incorrect since Applicant is entitled to all claimed rights in accordance with Section 251. This right includes all claims that may be broader or narrowed by reason of the patentee claiming more or less than he had a right to claim in the patent in accordance with the new and amended application. It is noted that this Examiner would consider e.g., all amendments to the original process claims pertaining to the same general invention or the allowed subject matter of Claim(s) 1 (and 2):

"A method of suppressing the growth of Gram-positive bacteria in a host medium, said host medium being selected from the group consisting of in vitro and cell cultures, said method comprising the introduction of an effective amount of a catecholamine to the host medium to act directly on the growth of Gram-positive bacteria."

As long as the amended claim(s) is(are) essentially to the same general invention, Applicant is entitled to narrow or broaden the allowable process

claim(s) by the addition or elimination of any subject matter which does not effect the inventive concept of the allowable process of suppressing the growth of the Gram-positive bacteria by the effective amount of the catecholamine.

2. Page 5-Statement #2. Applicant is correct in the statement that the claimed inventions were for a different invention.

3. Page 5-Statement #3. Applicant is incorrect in this statement since Applicant is entitled to all rights in accordance with Section 251 for Reissues. Applicant is entitled to the following as indicated in M.P.E.P. 1412.03 Broadening Reissue Claims:

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the patent. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable apparatus or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for direct infringement who previously could not have been sued for direct infringement.

However, the claims must comply with the following:

1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective

intent manifested by the original patent.” In re Amos, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting In re Rowand, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also In re Mead, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The “original patent” requirement of 35 U.S.C. 251 must be understood in light of In re Amos, supra, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both Mead and Rowand, a claim submitted in reissue may be rejected under the “original patent” clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter.

Merely finding that the subject matter was “not originally claimed, not an object of the original patent, and not depicted in the drawing,” does not answer the essential inquiry under the “original patent” clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an “intent,” even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

The cursory search and citation of patents by Applicant have been deemed not to be persuasive in view of the above legal decisions pertaining to Applicant’s rights to Reissues.

The prosecution history clearly indicates that Applicant had no intent for claiming the subject matter which subject matter has been submitted for the first time for “enhancing” in the file history of the original patent U.S. 3, 629,349, which error cannot be cured by a reissue under Section 251. Applicant has argued allegations pertaining to subject matter not claimed in the original patent but subject matter that was surrendered or abandoned in view of the file history. The [surrendering] or abandonment of the subject matter involved exceptionally very broad language which was in essence claiming the world of any living organisms and that the exceptionally broad claims were rejected by the Examiner (different Examiner in great grandfather and grandfather applications). Applicant had acquiesced to the rejection by submitting claims drawn to only “suppressing specific Gram-positive bacteria” which claimed subject matter was found allowable. Applicant had sufficient time to submit any additional subject matter prior including the claimed subject matter from 1992 to 1997 according to the alleged error by Applicant. It has been considered that there is nothing in the original patent U.S. 3,639,349, evidencing that Applicant intended to claim a method for “enhancing the growth

of bacteria.." or that applicant considered the methods now claimed to be their invention and therefore there was no error within the meaning of Section 251.

Page 10 of Remarks

Applicant is correct that no restriction was [not] submitted between the two opposite and patentably distinct process conditions of "suppressing" and "enhancing" since no claims were submitted to these different mechanisms. The generic claims alleged to support the claims under consideration [in] the Reissue were rejected not in the original patent but in parent [application(s)] based on three different rejections [in] which Applicant [had] acquiesced for the exceptionally broad claimed subject matter for the claims submitted in the application containing only one embodiment in which there was no generic claim submitted to "enhancing or enhancement....". The application [Serial Number 08/266,805] filed June 27, 1994 did not contain any generic claim as alleged nor any claims to the enhancement [of growth] of bacteria. **Applicant is not entitled based on the case history to now file claims to a different invention based on Section 251.**

Applicant is not entitled to any recapture of claimed subject matter cancelled in other patents applications which claimed subject matter was not in the original patent application, as in **M.P.E.P. 1412.02 Recapture of Canceled Subject Matter:**

A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. Claims 23-42 would have been rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based if the claims were in the original patented application and the same rejections were submitted which claims were cancelled to obtain the patent claims based on Claims 1 and 2 in the instant reissue application. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

According to the M.P.E.P. 1402 the "Grounds for Filing":

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent There must be at least one error in the

patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

Even if one accepts Applicant's arguments with respect to the broadening aspect present in the reissue which was not present in the application for patent, Applicant is not entitled to a reissue based on the alleged error. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to **subject matter that applicant previously surrendered during the prosecution of the parent application.** Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. In addition, Applicant's failure to timely file claims drawn to an embodiment not claimed in the original patent is not considered to be error causing a patent granted on other claimed embodiments to be partially inoperative by reason of claiming less than the applicant has a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C.[251]"

(11) Response to Argument

Response to SUMMARY OF THE ARGUMENTS:

1. **The Patent was granted for a specific invention, and the Reissue claims are to not only a different invention, but to the opposite invention.**

Applicant has stated that:

"The original intended scope of the invention was a truly generic invention of modulating the growth of microorganisms. That truly generic disclosure and the truly generic claims originally filed in the applications are generic to both the claims allowed in U.S. Patent No. 5,629,349 and the claims presently on Appeal. Just as claims to altering the volume of an audio device would include increasing and decreasing the volume, modulating clearly includes and was disclosed as including enhancing growth

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and suppressing growth. The **inventions are not opposite**, but they are intimately related.”

Response:

It should be noted that Applicant has been attempting to argue different applications containing varying subject matter as a continuous line of a truly generic invention but this is **absolutely not true**. Prior to responding to the line of the “truly generic invention”, it should be noted that Applicant **has not met the requirements for**

I. **Reissue Claims**

and

II. **Applicant has not met the two step requirements** recapturing of canceled

subject matter as recited in the M.P.E.P. 1412.02:

As noted in M.P.E.P.1412.01 whereby the

“ Reissue Claims Must Be for Same General Invention.

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is “an essentially factual inquiry confined to the objective intent manifested by the original patent.”

As recited above, the proper test for the reissue claims are drawn to the same invention as that disclosed as being the **invention in the original patent**. This is not the case in the instant Reissue Application. The claims are drawn to a clearly totally different patentably distinct invention in which the patented claims as noted on Page 33 of the Brief: “

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“Recapture of Canceled Subject Matter”

-----It is noted that the instantly rejected claims are broader than the instantly allowed patent claims which are recited on pages 33-35 whereby

Claim 1. recites “ A method of suppressing the growth of Gram-positive bacteria...” and

Claim 23 recites “ A method of enhancing the growth of bacteria...”. As stated in the patent for which the instant reissue is based on:

“In dramatic contrast to the growth enhancing effect of catecholamines on Gram-negative bacteria, FIG. 8 demonstrates that these compounds have essentially the reverse effect in Gram-positive bacteria. This trend was consistent for all Gram-positive bacteria tested and exemplified by the plot in FIG. 8. A 20 hour culture of *Staphylococcus aureus* representing an initial inoculum of 1600 CFU per well manifested a decline in ³H-thymidine uptake into new DNA. As concentration of catecholamines increased, suppression of growth increased.”

There is a completely opposite and a patentably distinct different effect for the patented “Gram-positive bacteria” compared to the “Gram-negative” bacteria whereby the Gram-positive leads to a suppressing effect while the Gram-negative bacteria imparts an enhancing effect. Also, the patent recited “In contrast, all Gram-positive bacteria tested showed a suppression of growth in the presence of the catecholamines tested.” Furthermore, the patent states: “In summary, it was noted that all Gram-negative organisms tested in these studies responded positively to the introduction of norepinephrine to their growth media. Enhancement of proliferation varied between organisms, with proliferation being the most pronounced for *E. coli*. This organism was sensitive to all catecholamines tested, in contrast to the majority of Gram-negative bacteria, which were sensitive only to the presence of norepinephrine and to a lesser effect, dopamine. This

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effect was not method specific and was manifested at a slower rate as initial bacterial inoculum increased. In contrast, all Gram-positive bacteria tested showed a suppression of growth in the presence of the catecholamines tested.”

The record clearly establishes that the rejected claims are drawn to a patentably distinct invention which does not conform to the “same general invention” based on issues.

II- In addition, Applicant has not met the requirements as recited in the M.P.E.P.

1412.02: **TWO STEP TEST FOR RECAPTURE:**

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The **first step** in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor* [*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The **first step** has been determined that the claims are broader than the **patent claims** in that the original claims are drawn to suppressing the growth whereas the rejected claims are drawn to enhancing growth. As noted above, the methods involving In contrast, all Gram-positive bacteria tested showed a suppression of growth in the presence of the catecholamines tested which is patently different from the enhancing of bacterial growth.

The **second step** is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

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In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim."

Where a claim in a reissue application is in fact broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination.

It was considered in the Final Rejection that Applicant had surrendered during the prosecution of the prior applications claims to the aspects pertaining to Gram-negative bacteria and enhancing growth which omitted limitations were not claimed in the patented file.

The M.P.E.P. further states:

CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, **the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.** > See MPEP § 706.02(1)(1) with respect to amendments made to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.

The examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. The record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered. A limitation of the patent claims is omitted in the reissue claims. (This is the case in the present reissue application Ser. No. 09/241,825) This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application.

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Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter.

Example

(C) The limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

The **first application Serial Number 07/730,485, filed July 16, 1991**, essentially presented a generic claim to :

“A method of affecting the rate of proliferation of living organisms and vectors.....to modify the level of presence of a neurotransmitter chemical.....comprising the steps (a).....(b) adjusting the level of presence of said neurotransmitter to produce an effect upon said rate; (c) assessing efficacy of said application in step (b) in reducing or enhancing said rate; and (d) repeating.....rate.”

This application was Expressly abandoned on February 24, 1992.

The second application which Applicant refiled a CIP application Serial Number 07/753,709, filed September 03, 1991, presenting essentially the same claims. Not one single

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claim was drawn to any invention containing two of the following limitations (a) Gram-positive or Gram-negative bacteria, (Claims 5, 13-drawn to generic Gram-test) (b) catecholamine (Claims 8, 16, 23) and (c) enhancing or suppressing (generic claim only-not specific to either enhancing or suppressing).

All of the claims were rejected as under 35 U.S.C. 102/103 on March 25, 1992 over four distinct art references which clearly demonstrated the undue breadth of the claimed subject matter for which Applicant did not respond to the rejection.

This application was Abandoned on April 30, 1993.

The third application which Applicant refiled was a CIP application Serial Number 07/847,196 filed March 06, 1992 changing the broad generic claim to essentially

Claim 1 "A method for affecting the growth of vectors and cell cultures and living organisms,and living organisms being characterized by the presence of at least one catecholamine receptor site, said method comprising the steps of: administering at least one chemical compound.....; and in an amount sufficient to effect a desired level of growth of said vectors and living organisms."

Claim 14 " A method for depressing the growth of vectors and cell cultures and living organisms, said vectors and cell cultures and living organisms being characterized by the presence of at least one catecholamine receptor site, said method comprising the steps of: administering at least one chemical compound, said chemical compound.....in an amount sufficient to effect a desired level of growth of said vectors and living organisms."

Claim 19 " A method for stimulating the growth of vectors and cell cultures and living organisms, said vectors andpresence of at least one catecholamine receptor site, said methodadministering said chemical compound in an amount sufficient to effect a desired level of growth of said vectors and living organisms."

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Not one single claim to all of the limitations of catecholamine with (suppressing or enhancing /stimulating) with Gram-positive or Gram-negative bacteria.

The first Office action on September 25, 1992 was a rejection based on the same four patents as submitted in the previous Application, Serial Number 07/753,709. An amendment filed December 12, 1992 was submitted which cancelled Claims 1-23 and added new claims 24-33. Applicant had cancelled the subject matter drawn to "enhancing or stimulating" and presented arguments drawn only to the patentability of Gram-positive organism growth in the presence of catecholamine. **Applicant had conceded and abandoned all subject matter based on the prior art which Applicant is now attempting to recapture. It is clear that the claimed subject matter was limited to the suppression and Applicant had an opportunity to keep or present the subject at that time or in any future cases while at least one application was pending.**

Examiner of record submitted a restriction requirement on March 23, 1993 to the new claims both of which were drawn to only methods of suppressing growth with catecholamine alone or with a blocker. Applicant had the opportunity to present claims to the methods of enhancing growth but did not present any claims.

The response to the election on April 19, 1993 was without traverse to elect the methods of suppressing growth using catecholamine without a blocker.

The Examiner rejected the claims on July 13, 1993 based on new prior art.

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Applicant had argued the rejections based on the art on September 20, 1993.

Examiner of record finally rejected the claims on December 27, 1993 based on two new prior art references.

Applicant submitted an After Final amendment on March 17, 1994 which was not entered by the Examiner of record as noted by the Advisory action on March 21, 1994.

The fourth application, Serial Number 08/266,805, was filed on June 27, 1994 which matured into U.S. 5,629,349 which is the basis for the instant reissue application Ser. No. 09/241,825.

In the preliminary amendments filed June 27, 1994 presented only Claims 24-28 drawn to the same two Inventions which were restricted in previous application. The Examiner of record submitted essentially the same restriction requirement on January 31, 1995 drawn to methods of suppressing the growth of Gram-positive alone or in the presence of blockers.

This new application Serial Number 08/ 266,805 filed did not have any generic claim drawn to the different inventions as now claimed.

The broad claim 24 states:

“A method of suppressing the growth of Gram-positive organisms of interest in a host medium, said method comprising the introduction of a sufficient amount of a catecholamine to the host medium in a manner such that it acts directly on the Gram-positive organisms.”

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Applicant had the opportunity to present claims to methods of enhancing in the present case or in a copending case which would have been restricted as being drawn to a different invention.

The claims were rejected on March 23, 1995.

Applicant submitted an amended claim on June 23, 1995.

Examiner responded with a Final Rejection on October 19, 1995.

Applicant submitted arguments on April 16, 1996 for allowance of the claimed subject in which it was stated "...the Examiner is requested to consider FIGURE 8, which shows a direct relation between the concentration of several catecholamines and Gram-positive bacteria. This clearly shows a direct inhibition relationship and, as described on Page 18 of application's specification beginning with Line 11, this trend was consistent for all Gram-positive bacteria tested."

This statement is in conflict with the new claims since Claim 25 is indicating that catecholamine enhances the growth of Gram-positive bacteria.

In an Examiner's Amendment in Serial Number 08/266,805 on July 1, 1996, the withdrawn claims were cancelled and the application was allowed. Applicant had an opportunity from the time of allowance to May 13, 1997 (the date of issuance of the patent) to file a copending application drawn to any inventions, included including the instantly rejected claims in this Reissue application.

In accordance with ¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

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Claims 23-42 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue **which was not present in the application for patent**. The record of the application for the patent shows that the **broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application**. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Part 2. On Page 11: **The rejection asserts that Applicant abandoned the subject matter of the claims on Appeal.**

Response: Applicant is not in full compliance with the requirements as noted above whereby the reissue Application must be directly correlated with the Patent application claims. The claims are drawn to patentably distinct inventions which subject matter was cancelled and effectively abandoned in the parent applications of the patented application as indicated in the

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above paragraphs. The request is not in compliance with the required two step test for recapture of surrendered subject matter.

Part 3. Applicant never intended to claim the subject matter on Appeal in the prosecution of U.S. Patent No. 5,629,349.

Applicant has argued on **Page 11**, last two lines, that:

“Any reading of the claims originally filed in the application that issued as U.S. Patent No. 5,629,349 will show an intent to claim an invention generic to both enhancement and suppression of bacterial growth and viral growth. Evidence was actually introduced in the form of a letter from the inventor to prior counsel showing a lack of comprehension on why the scope of the claims was being diminished.”

Response:

Examiner disagrees with the statement since application Ser. No. 08/266805 contained only claims drawn to two inventions both drawn to method of suppression of growth and no enhancement of growth as alleged, see first restriction dated January 31, 1995. With respect to alleged intent with correspondence between the Inventor and his Attorney who was given full authority to act on his behalf is not persuasive. Applicant had given his Attorney authority to act on his behalf and if he was unsatisfied with the scope of the claims, Applicant had the opportunity to obtain the services of another Attorney.

The arguments presented on pages 15-16 pertaining to alleged difference between his Attorney and lack of consultation of patent matters carry little weight for the lack of presenting claims to the rejected claims. The letter submitted to his Attorney on February 14, 1994 alleging

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a lack of sufficient scope on the part of claims is clearly not on record nor did the Examiner of record have any knowledge of any allegations for this lack of sufficiency of scope. Applicant had an opportunity and sufficient time to rectify the situation prior to the issue date, May 13, 1997, of Applicant Serial Number 08/266805 now U.S. Patent 5,629,349, a period more than three years. The Patent Office in no way acted in any way to diminish or prevent Applicant from properly presenting claims drawn to any enhancement or growth in any patent application.

FACTOR I-Response. The arguments that:

“the Applicant was not being properly informed of decisions made by counsel, Applicant cannot be held to have abandoned inventions that were never restricted out of the application.”

has been deemed not to be persuasive since Applicant had given full authority to the Attorney of record to act on his behalf and any lack of communication between the Applicant and his counsel is not within the jurisdiction of the PTO.

Applicant had effectively abandoned the claims as noted above with respect to the methods of enhancement and the reissue is not in compliance in attempting to recapture surrendered and abandoned subject matter.

Page 20: Applicant has stated: “The original claims submitted in the Application Serial No. 08/266,805 still contained the generic claims (e.g. claim 1) for affecting the growth of vectors and cell structures” that constituted a generic invention.”

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Applicant is absolutely in error in the above statement "original claims submitted in the Application Serial No. 08/266,805 still contained the generic claims" since claim 1 was cancelled in the parent application, Serial Number 07/847,196, abandoned, and not present in application Serial No. 08/266,805 which matured into Patent No. 5,629,349. This is additional evidence that Applicant is not entitled to any reissue based on the rejected claims. Arguments based on false allegations carry little weight. Additionally, Applicant is again alleging lack of consultation with his counsel for which the PTO does not have any jurisdiction pertaining to any allegations of mistakes by his counsel for not presenting broader claims. The record does show that very broad claims were submitted as indicated in the earlier applications for which the very broad claims which included enhancement of growth inventions were abandoned due to prior art.

Page 21: The remarks are again drawn to allegations that Applicant was not informed nor understood limitations of the claimed language which is not the fault of the PTO since Applicant had given full authority to his counsel to represent him in the PTO.

Pages 22-24: Applicant is alleging that the claims are narrower in scope than the original claims which is **again absolutely erroneous since the original claims in the Patent were not drawn to the subject matter as alleged.**

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Page 25-26: Factor 2-Different Inventions:

Response:

The record clearly indicates that there are two separate and distinct inventions submitted in the reissue. Again, the prior application, Ser. No. 08/266,805 did not contain any alleged generic claim and all remarks based on erroneous facts carry little weight and the arguments have been found not to be persuasive. It is clear that claims 1-23 were not present in the original application Ser. No. 08/266,805 as alleged on page 25.

Page 27: FACTOR 3-LACK OF INTENT TO CLAIM THE SPECIES NOW CLAIMED IN THE REISSUE

Applicant has again argued that:

“broader claims that those presently in the Reissue Application were present in the Application that resulted in U.S. Patent No. 5,629,349.”

THIS STATEMENT IS ABSOLUTELY NOT TRUE SINCE BROADER CLAIMS WERE NOT PRESENT IN THE APPLICATION, AS FILED

“ Original claims 1-23 were pending in 07/847,196 which was continued as U.S. patent Application 08/266,805.”

THIS STATEMENT IS TRUE AND IS THE FIRST TIME APPLICANT HAS INDICATED
IN WHICH APPLICATION CLAIM 1 WAS PRESENT.

“ As the Supreme Court has held that a continuation application is in fact the same as the parent application, even though different time periods may apply, the Claims were by Case law present in this application.”

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THIS STATEMENT IS TRUE WITH RESPECT TO THE FACT THAT THE SAME
DISCLOSURE IS PRESENT IN BOTH CASES AS WELL AS THE SUPPORT FOR THE
CLAIMS BUT NOT TRUE FOR THE CLAIMED SUBJECT MATTER

PAGES 28-31

The arguments are based on false allegations as to the scope of the parent application and the comments have been found not to be persuasive based on premises that the parent application, Serial Number 08/266,805, contained generic claims. In addition, the argument that a divisional can be filed only as a result of a restriction requirement is not accurate since a divisional can be filed when a second invention not claimed in first application is newly claimed. The subject matter can also be filed as a CONTINUATION or a CIP.

SUMMARY

In view of the above, it is clear that:

1. Applicant is not in compliance with M.P.E.P. 1412.01

“ The reissue claims must be for the same general invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251.”

2. Applicant does not meet the standards of M.P.E.P. 1412.02 “Recapture of Canceled Subject Matter -A reissue will not be granted to “recapture” claimed subject matter which was surrendered in an application to obtain the original patent.” since the claimed subject matter was abandoned in the prior applications.

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3. Applicant does not meet the standards as required by the TWO STEP TEST FOR RECAPTURE as indicated in M.P.E.P. 1412.02.

4. Applicant has argued that the claimed rejected subject matter is narrower in scope than Claim 1 of the application which was patented but this Claim was never presented as a Claim per se in the patented application. All arguments pertaining to the scope of the claimed subject matter are erroneous.


5. The claimed subject matter was abandoned in the prior application based on prior art and Applicant had surrendered the subject matter.

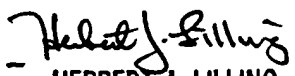
6. Applicant had numerous opportunities to submit an application to the rejected claimed subject with a DIVISIONAL, CONTINUATION or CIP applications during the copendency of the various applications and failed to do so.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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December 18, 2000


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